

REMARKS

The application has been carefully reviewed in light of the Office Action dated May 13, 2004. Claims 1-12 remain pending in this case.

Rejection under 35 U.S.C. § 112

Claim 7 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 7 is believed to be in compliance with § 112 based on disclosures in the specification. The limitation, “sending the geographic location to an external server on the external network” is described at page 41, line 19 – page 42, line 2. Specifically, “the website 60 can adjust the information delivered to the user 5 based on its geographic location.” The limitation, “redirecting a machine associated with the Internet user to the external server” is described at page 41, line 19 through page 42, line 2. Specifically, “the internal server 99 redirects the user 5 back to the web site 60 with added information about the geographic location of the user 5.” Page 41, lines 19-20. In conjunction with FIG. 15 showing the web site residing outside the internal network, Applicant respectfully submits that claim 7 complies with § 112.

Rejection under 35 U.S.C. § 103

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCanne et al. (U. S. Patent No. 6,415,323) in view of Lamm et al., “Real Time Geographic Visualization of World Wide Web Traffic”, WWW Journal Issue 3.

Claim 1 recites a method of obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server comprising *inter alia* “receiving by an external server on the external network a request for information from an

Internet user through the proxy server” and “determining by the external server that the request for information is through the proxy server.” Claim 1 also recites “redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user” and receiving by the external server the geographic location from the internal server within the private network.”

Claim 3 recites a method for determining a geographic location of an Internet user that accesses an external network from a private network through a proxy server comprising *inter alia* “receiving a request for the geographic location of the Internet user within the private network, the request originating from the external network outside of the private network.”

Claim 8 recites a method for obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server comprising *inter alia* “receiving, by an internal server on the private network, a request for the geographic location of the Internet user from an external server on the external network” and “determining, by the internal server, the geographic location of the Internet user located inside the private network.”

Claim 10 recites a method for resolving a domain name inquiry to assist in gathering a geographic location of an Internet user comprising *inter alia* “resolving the inquiry if the inquiry did not originate from within the private network, the first IP address being associated with an external server located outside of the private network” and “resolving the inquiry by returning a second IP address if the inquiry did originate from within the private network, the second IP address being associated with an internal server located inside the private network. Claim 10

also recites that the “internal server and external server are for determining the geographic location of the Internet user and for making this geographic location information available.”

McCanne discloses a proximity-oriented redirection system for service-to-client attachment in a virtual overlay distribution network. The device of McCanne employs a service rendezvous. “Service rendezvous entails a system by which it is possible to: (1) publish a single name for a service; (2) replicate the service throughout the network; and (3) have each client that desires the service receive it from the most appropriate server.” McCanne, column 4, lines 59-63. In a service rendezvous, “if there is no nearby service node capable of servicing the request, the system should be able to redirect the client to a service node elsewhere in the network across the wide area to service the request.” McCanne, column 5, lines 3-7. A problem noted in McCanne of a service rendezvous is, “unfortunately, service rendezvous is a difficult problem, because the Internet architecture deliberately hides the underlying structure of the network to impose flexibility and robustness upon higher-layer protocols, so it is difficult to discover and use a selected server for a particular network transaction. To overcome these problems, the rendezvous service described in McCanne exploits “anycast” routing, a network-level mechanism that can be used to route user requests to nearby service nodes based on topological locality.” McCanne, column 5, lines 16-25.

Lamm discloses a geographic location mapping system. Lamm mentions that “to map IP addresses to geographic location, we first determine the domain name. For locations outside the United States, the suffix of the domain name typically is an abbreviation of the country name.” Lamm, page 3, 2nd paragraph. Lamm also admits, “despite our high success rate, network firewalls and national online services limit the accuracy of the latitudes and longitudes. For

instance, an America Online ("AOL") user might connect via modem from Irvine, California, and access the NCSA "What's New" page. That person's IP address (aol.com) would yield Vienna, Virginia, as its location because that is the site of the AOL headquarters. Similar problems arise with large, geographically disperse corporations that maintain a single Internet point of contact. Fortunately, such cases can be identified by name and can often be parsed by decomposing the domain name (e.g., intgate.raleigh.ibm.com is easily identified as an IBM site at Raleigh, North Carolina)." Lamm, page 3, 5th paragraph.

The Office Action fails to establish a *prima facie* case of obviousness of the subject matter of claims 1-12. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, either in the references themselves or in the knowledge of a person of ordinary skill in the art, to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. *See, e.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). The Office Action fails to establish a *prima facie* case of obviousness for the subject matter of claims 1, 3, 8 and 10 because the proposed combination fails to disclose, teach or suggest all claim limitations and there is no motivation to combine the cited references.

In the present case, McCanne and Lamm fail to teach or suggest the subject matter of claim 1 which includes in combination with other steps, "receiving by an external server on the external network a request for information from an Internet user through the proxy server" and "determining by the external server that the request for information is through the proxy server"

and “redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user.”

Specifically, McCanne uses an autonomous system (AS). In using the AS, “when a packet enters the master AS (from anywhere in the Internet), it is routed to the CBB service node that is closest to the border router traversed by the packet upon entering the master AS.” McCanne, column 8, lines 17-21. McCanne also uses anycast communications. In using an AS to determine geographic location, McCanne is limited to determining a broad geographic location for a server within a network, i.e., a country as opposed to a city or regional level for a particular Internet user.

While McCanne may mention acquiring a geographic location for a user, this reference merely refers to a geographic location of an Internet user within a network map, and not a physical location. See, McCanne, column 3, lines 40-45. In addition, the Office Action states “McCanne does not teach the internal server determining the geographic location of the user; receiving by the external server the geographic location from the internal server within the private network; and using the geographic location of the Internet user in handling the request for information from the Internet user.” In order to overcome the admitted deficiencies in McCanne, the Office Action relies on Lamm.

However, Lamm fails to remedy the deficiencies in McCanne. Specifically, Lamm expressly states its system is not accurate when encountering network firewalls or private and semi-private networks. See, Lamm, page 3, 5th paragraph. This is a fundamental problem of obtaining geographic locations of Internet users. See, present application page 4, line 21 – page 5, line 11. Applicant submits that Lamm fails to teach or suggest an “internal server

determining the geographic location of the user; receiving by the external server the geographic location from the internal server within the private network; and using the geographic location of the Internet user in handling the request for information from the Internet user.” In addition, Lamm determines geographic locations outside the United States using the suffix of the domain name. As stated in the present application, certain suffixes associated with locations outside the United States are used by users within the United States. See present application, page 2, lines 2-6. Emphasis added. Thus, the device of Lamm would yield an incorrect determination regarding the geographic location of an Internet user when using the suffix “md” if the Internet user is a doctor residing in the United States since “md” is actually the top level domain for the Republic of Moldova. Thus, the combination of McCanne and Lamm fails to teach or suggest all the limitations of claim 1.

In addition, there is no motivation to combine McCanne and Lamm. Specifically, McCanne utilizes a service rendezvous technique that requires an anycast communication, “the rendezvous service described herein exploits ‘anycast’ routing.” See McCanne, column 5, lines 3-27. Anycast is a communication between a single sender and the nearest of several receivers in a group. In contrast, Lamm discloses a multicast communication, which is used when querying locations outside the United States since a single device is communicating with multiple receivers to determine a location. Thus, McCanne and Lamm use incompatible communication techniques. As noted above, “[s]ervice rendezvous entails a system by which it is possible to: (1) publish a single name for a service; (2) replicate the service throughout the network; and (3) have each client that desires the service receive it from the most appropriate

server.” Lamm does not utilize a service rendezvous. Accordingly, the rejection of claim 1 should be withdrawn.

Claim 2 depends from claim 1 and is allowable along with claim 1 for at least the reason that it depends from an allowable independent claim.

The combination of McCanne and Lamm fails to teach or suggest the subject matter of claim 3, which includes in combination with other steps “receiving a request for the geographic location of the Internet user within the private network, the request originating from the external network outside of the private network.” For the reasons mentioned above regarding claim 1, claim 3 is also allowable over the combination of McCanne and Lamm since neither teach nor suggest the step of “receiving a request for the geographic location of the Internet user within the private network, the request originating from the external network outside of the private network.” Accordingly, the rejection of claim 3 should be withdrawn.

Claims 4-7 depend from claim 3 and are allowable along with claim 3 for at least the reason that they depend from an allowable independent claim.

The combination of McCanne and Lamm fails to teach or suggest the subject matter of claim 8, which includes in combination with other steps “receiving, by an internal server on the private network, a request for the geographic location of the Internet user from an external server on the external network” and “determining, by the internal server, the geographic location of the Internet user located inside the private network.” For the reasons mentioned above regarding claim 1, claim 8 is also allowable over the combination of McCanne and Lamm since neither teach nor suggest the steps of “receiving, by an internal server on the private network, a request for the geographic location of the Internet user from an external server on the external network”

and “determining, by the internal server, the geographic location of the Internet user located inside the private network.” Accordingly, the rejection of claim 8 should be withdrawn.

Claim 9 depends from claim 8 and is allowable along with claim 8 for at least the reason that it depends from an allowable independent claim.

The combination of McCanne and Lamm fails to teach or suggest the subject matter of claim 10, which includes in combination with other steps “resolving the inquiry if the inquiry did not originate from within the private network, the first IP address being associated with an external server located outside of the private network” and “resolving the inquiry by returning a second IP address if the inquiry did originate from within the private network, the second IP address being associated with an internal server located inside the private network.” For the reasons mentioned above regarding claim 1, claim 10 is also allowable over the combination of McCanne and Lamm since neither teach nor suggest the steps of “resolving the inquiry if the inquiry did not originate from within the private network, the first IP address being associated with an external server located outside of the private network” and “resolving the inquiry by returning a second IP address if the inquiry did originate from within the private network, the second IP address being associated with an internal server located inside the private network.” Accordingly, the rejection of claim 10 should be withdrawn.

Claim 11 and 12 depend from claim 10 and are allowable along with claim 10 for at least the reason that they depend from an allowable independent claim.

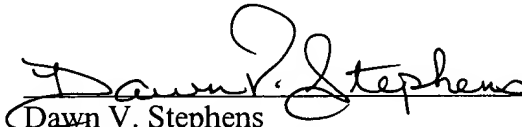
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

ATTORNEY DOCKET NO. 04159.0001U2
APPLICATION NO. 09/632,959

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$885.00, representing the fees for an RCE and an Extension of Time is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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11/12/04
Date